

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:
DANIEL A. GATELY	: Art Unit 1621
Serial No. 09/016,641	:
Filed January 30, 1998	:
FOR: SILYLATED AND N-SILYLATED	: Examiner: J. Vollano
COMPOUND SYNTHESIS	:

RENEWED PETITION UNDER 37 C.F.R. §1.144

Honorable Commissioner of
Patents and Trademarks
Washington, D. C. 20231

Sir:

This "Renewed Petition" under 37 C.F.R. §1.144 requests reconsideration of the Petition Decision mailed January 10, 2000. Because Mr. John Kittle, Director, Technology Center 1600/2900 signed both of the petition decision in this case, familiarity with the record is assumed. Prior submissions will not be reiterated, except to the extent deemed necessary.

It is noted that the January 10, 2000 Decision correctly states that applicant "refer[s] to 35 U.S.C. 103(a) and 35 U.S.C. 121 for defining the meaning of the term 'invention'" (p. 1). Applicant's position, as stated in the original petition filed May 28, 1999, was and still is that:

The word "invention" must have the same meaning in §103(a) and §121 of Title 35. Therefore, the word "invention" in §121 must mean the claimed "subject matter as a whole", just as in §103(a). For that reason, it is indeed "inappropriate...to restrict within a claim" (action, p. 9). [p. 3]

If the Commissioner's position is that the second sentence of the foregoing quotation from the first Petition is wrong, it is requested that the decision on this petition say so directly and forthrightly.

It is also requested that such petition, if taken by the Commissioner, be explained and justified.

The first paragraph of the January 10, 2000 decision goes on to state:

Applicant argues that the concept of having more than one invention claimed within a single claim "clashes with 35 U.S.C. 103(a) and 35 U.S.C. 112" in that such a concept could force an applicant to fragment the claimed invention as a whole. However, M.P.E.P. 803.02 sets forth instances in which this exact scenario may be effected by the examiner. An examiner may require an election of species to facilitate examination purposes and upon proper election examine only a portion of a claim. Depending on what prior art is found, a claim may eventually be fragmented into various distinct species which are separately patentable while the genus is not patentable.... [p. 1]

A short answer is that M.P.E.P. §803.02 is invalid to the extent that it may "set[] forth [and condone] this exact scenario". §803.02 is not so flawed, however, because it does not condone such a "scenario". The postulate that it does is

based on "an election of species" under 37 C.F.R. §1.146. That rule is careful to state:

In a first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable....

There is no "fragmentation" of the "invention as a whole" defined by an original generic claim because, by definition, before any election requirement may be enforced, it must be determined that the generic claim is not patentable. Further, by definition in Rule 146, election may be required, but only between "patentably distinct" species claims. A species claim is not "patentably distinct" if it would be "obvious" in view of another claimed species.

The issue on this—and earlier petitions—is whether the restriction requirement at issue is proper under 37 C.F.R. §1.142(a). That rule is concerned with a single application that includes claims to "two or more independent and distinct inventions" [emphasis added].

The January 10, 2000 Petition Decision states:

Applicant's original petition contends that the examiner's restriction requirement is "illogical and inconsistent" because the examiner places several claims in two or more groups among which restriction is required. Applicant argues that a single claim cannot contain two distinct and unrelated inventions. However, such an argument, especially in the chemical compound/composition art, is not valid. There are and have been many instances in which a claim has included widely dissimilar and unrelated chemical compounds/compositions and restriction, rather than election of species, therebetween has been proper.... [p. 1]

In context, applicant's original petition states:

Applicant's Reason 2(a) [of the Request for Reconsideration filed 1/19/99] states:

2. The restriction requirement is illogical and inconsistent in the following respects:

(a) The examiner's invention "I" includes "Claims 1-3(in part) and 4"; whereas, the examiner's invention "II" includes "Claims 1-3(in part), 5-6 and 14-15". If, as the examiner's invention "I" admits, claim 4 can properly be examined with claims 1-3, then claim 4 can properly be examined in connection with claims 1-3, 5-6 and 14-15 which comprise the examiner's invention "II".

The assertion in paragraph 2 of the restriction requirement that inventions "I" and "II" are "unrelated" is contradicted by the fact that "Claims 1-3(in part)" are included in each of inventions "I" and "II".

Inventions "I" and "II" should be combined to yield a single "invention". [p. 4]

The original petition, rejecting the examiner's technical discussion, then states:

This argument is not persuasive for at least three reasons:

(ii) It evades and so tacitly concedes, applicant's common sense point that:

If, as the examiner's invention "I" admits, claim 4 can properly be examined with claims 1-3, then claim 4 can properly be examined in connection with claims 1-3, 5-6 and 14-15 which comprise the examiner's invention "II". [p. 5]

This "common sense" point is again made by the January 10, 2000 Petition Decision.

This Renewed Petition warrants a ruling that:

- (i) overrules the requirement for restriction between Inventions "I" and "II", or
- (ii) includes a common sense rebuttal, on the merits of the logic involved, of applicant's "common sense" point.

Put in other terms, applicant's common sense point compels the conclusion that Invention "I" and Invention "II" are "related" and, hence, not "independent and distinct" (§1.142); wherefore, the requirement for restriction involving 35 U.S.C. §121 is improper.

The same is true as to the requirement for restriction between Inventions "III" and "IV".

Finally, applicant maintains the position, as set forth on page 4 of the Renewed Petition filed November 22, 1999:

The Decision [dated September 21, 1999] states:

The criteria for requiring an election of species in a Markush group, as noted above, is that the compounds share a substantial feature disclosed as essential to the utility claimed. The examiner could find no shared substantial structural feature directed to the utility claimed and therefor a restriction requirement was made. The examiner also gave extensive reasons for restriction including basic versus acidic properties, reactivities, etc. For the same reasons, the claims directed to the making of the individual compounds, claims 7 and 8, were divided into two separate groups corresponding to the restriction of the compounds in Groups I and II. The claims of Group V are to making compounds not related to the compounds of Groups I-IV and are thus properly restrictable. [p. 3; emphasis in original]

Under those "criteria", the proper procedure was for the examiner to require "election" as between the two "species" said to be recited in claim 1. The examiner is without power to, in effect, order such a claim 1 species election sua sponte, and then combine the sua sponte elected species with sua sponte elected fragments of another claim and demand "restriction" as to the artificial "invention" so created by the examiner but never claimed by applicant. [p. 4]

The January 10, 2000 Decision does not respond to this position of applicant. Applicant is entitled to a reasoned response.

RELIEF REQUESTED

The relief requested is that the original restriction requirement be withdrawn.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Any fee due in connection with this "Renewed Petition" may be charged to Deposit Account 09-0948.

REMINDER OF CHANGE OF ADDRESS OF COUNSEL

The examiner's attention is called to the previously-filed notice that counsel's address and telephone numbers have changed to:

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